

REMARKS

In view of the following remarks, the Examiner is requested to withdraw the rejections and allow Claims 1-16 and 28, the only claims pending and under examination in this application.

Claim Rejections - 35 USC § 103

Claims 1-16 and 28 were rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al (US Patent No. 5,186,824, issued 16 February 1993) in view of Schleifer (A) (US Patent No. 6,077,674, issued 20 June 2000) or Schleifer (B) (US Patent No. 6,309,828, issued 30 October 2001).

In making this rejection, the Examiner alleges that it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to apply the polymers synthesized by Anderson et al to the further step of addressable array fabrication taught by Schleifer (A) or Schleifer (B) (addressable immobilization of pre-synthesized polymers) and therefore arrive at the claimed invention.

The Examiner's rejection is based on the assumption that the claims read on a method in which polymers are presynthesized and then deposited at specific locations to produce an addressable array.

The Applicants respectfully disagree with the Examiner's interpretation of the claims. The subject claims include the step of:

"(c) reiterating steps (a) [contacting blocked monomers] and (b)[removing blocking groups] at least once to produce said addressable array of at least two polymeric ligands".

As such, the claims are directed to an in situ fabrication process in which an addressable array is produced by synthesizing polymeric ligands directly on the surface of a solid support in manner that sequentially adds the monomeric units one at time.

Anderson et al does not teach or suggest the *in situ* production of an addressable array of at least two different polymeric ligands as claimed. Nor does the Examiner allege that Anderson et al teaches or suggests an in situ process. Accordingly, Anderson is fundamentally deficient in failing to teach or suggest an in situ fabrication process as claimed.

Since Schleifer (A) and Schleifer (B) were cited by the Examiner solely for the purpose of an alleged teaching of making an addressable array by depositing premade polymers onto a surface of a support, these supplemental references fail to make up for the fundamental teachings in the primary reference.

In fact, because they teach one to deposit premade polymers onto a surface, they in fact teach away from producing the polymers on the surface in situ.

As such, Claims 1-16 and 28 are not obvious under 35 U.S.C. 103(a) over Anderson et al (US Patent No. 5,186,824, issued 16 February 1993) in view of Schleifer (A) (US Patent No. 6,077,674, issued 20 June 2000) or Schleifer (B) (US Patent No. 6,309,828, issued 30 October 2001) and this rejection should be withdrawn.

Double Patenting

Claims 1-16 of this application are rejected under the doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent Application Nos. 10/813,467; 11/234,701; 10/813,331 and 11/082,006.

The previous rejections under obviousness-type double patenting are maintained because the Terminal Disclaimers previously submitted are assertedly not acceptable.

The Applicants provide herewith a Terminal Disclaimer over U.S. Patent Application Nos. 10/813,467; 11/234,701; 10/813,331 and 11/082,006.

The Applicants note that the filing of a Terminal Disclaimer to obviate a rejection based on non-statutory double patenting is not an admission of the propriety of the rejection.¹ As such, while the Applicants firmly believe that this rejection fails to meet the requirements for Obviousness-Type Double Patenting set forth in MPEP § 804, a Terminal Disclaimer is nevertheless filed.

Accordingly, in view of terminal disclaimer(s) filed herewith, the Applicants respectfully request that this rejection be withdrawn.

¹ *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). The court indicated that the "filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection."

CONCLUSION

In view of the amendments and remarks above, the Applicants respectfully submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Bret Field at (650) 327-3400.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-1078.

Respectfully submitted,

Date: July 11, 2007

By: 

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Enclosures:

Enclosure(s): Terminal Disclaimer(s) as to U.S. Patent Application Nos. 10/813,467; 11/234,701; 10/813,331 and 11/082,006.

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